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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,439	04/13/2004	Volkmar Teichgraber	30882/DP016	4835
4743 7590 02/26/2009 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606-6357			EXAMINER JABR, FADEY S	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 02/26/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,439

Applicant(s)

TEICHGRABER ET AL.

Examiner

FADEY S. JABR

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1 and 9 have been amended. Claims 1-10 are pending and are again presented for examination.

Response to Arguments

1. Applicant's arguments filed 1 December 2008 with respect to 35 U.S.C. 101 have been fully considered but they are not persuasive. Applicant argues that the mechanical sorting of the mailpieces accomplishes a "useful, concrete and tangible result." However, Examiner notes that the 101 rejection is not based on the "useful, concrete and tangible result", but rather positively reciting another statutory class or positively reciting the subject matter that is being transformed. In regards to claim 1, the claim fails to recite another statutory class performing the critical steps. Thus, the rejection is upheld.
2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-8 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter

(such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-8 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avant, U.S. Patent No. 6,976,621 B1 in view of Moed et al., U.S. Patent No. 5,770,841, hereinafter referred to as Avant and Moed, respectively.

As per Claims 1, 3 and 8-10, Avant discloses a system and method comprising:

- detecting information present on at least one surface of a mailpiece and applying a machine-readable identification code onto the mailpiece at a sorting station
(C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);

- transmitting the detected information and an appertaining identification code to an interface computer and storing the detected information and the appertaining pertinent identification code (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);
- accessing the stored information and the stored identification code and determining address information on the basis of the detected and stored information (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);

Avant fails to *explicitly* disclose comparing the detected address information with address information present in a *plurality of sources* of a database. However, Avant discloses a USPS master address database (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35). Thus, It would have been obvious to one of ordinary skill in the art to include more than one source in a database. Further, Moed teaches checking the address against the USPS's Zip+4 database (C. 3, lines 61-64).

Avant fails to *explicitly* disclose associating the detected address information with new address information, *in case of a detected defective address information*, on the basis of the comparison that has been carried out. However, Avant discloses a lookup request to DSU 514. Once the ZIP code has been resolved for mailpiece 100, DSU 514 then retrieves and returns the ZIP code corresponding to ID Tag 204 to OSS 504, and OSS 504 then applies POSTNET code 202 to mailpiece 100, if necessary. OSS 504 then verifies POSTNET code 202 to confirm that POSTNET code 202 is legible. If OSS 504 cannot verify POSTNET code 202, mailpiece 100 is sent to LMLM 506 for manual processing as described above (C. 5, lines 60 – C. 6, lines 12, C.

8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35). Further, Moed teaches an invalid address information which is then displayed on an operator workstation (C. 2, lines 42-43).

- transmitting the associated new address information and the appertaining identification code to the interface computer (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35, also see Figure 11);

Avant fails to disclose sorting and displaying the new address information in a selection list and choosing address information for applying onto the mailpiece from the selection list. However, Moed teaches an operator reads the destination address from the display and manually enters it into the computer terminal or selected the correct address from a displayed list of possible addresses (C. 4, lines 2-5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include displaying correct addresses as taught by Moed in the system of Avant, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

- detecting the identification code applied onto the mailpieces and applying the new address information onto the mailpiece wherein the new address information is derived from the information read from the mailpiece and is applied as a function of the identification code ((C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35, C. 14, lines 38-55); and
- sorting the mailpieces mechanically so as to match actual sequence of delivery (C. 3, lines 43-45).

As per Claim 4, Avant discloses applying the new address information onto the mailpiece in coded form (C. 6, line 30).

As per Claim 5, Avant discloses wherein the address information comprises a barcode (C. 6, line 30).

As per Claim 6, Avant fails to *explicitly* disclose wherein the address information at least partially in plain text. However, Moed discloses address information printed on a label and a barcode (see Figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include printed address information on a mailpiece as taught by Moed in the system of Avant, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

7. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avant in view of Moed as applied to claim 1 above, and further in view of Didriksen, International Publication No. WO 00/00300, hereinafter referred to as Didriksen.

As per Claims 2 and 7, Avant fails to disclose processing the mailpieces according to a *two-stage process*. However, Didriksen teaches a sortation sequence may be used at the first

and/or at the second item processing installation as well as in distributing of items and during final delivery of items at the respective destination locations (pp. 10, lines 15-26, pg. 15, lines 16-25, pp. 28, lines 4-22).

It would have been obvious to one of ordinary skill in the art to include in the mailing system of Avant the ability to further process mail items as taught by Didriksen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr

Examiner
Art Unit 3628

FSJ

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/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628